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EXAMINER				
WALSH, DANIEL I				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/586,974

Applicant(s)

ICHIKAWA ET AL.

Examiner

DANIEL I. WALSH

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 2-4-08. Receipt is acknowledged of the IDS received on 7-25-06. The information disclosure statement filed 7-25-06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. There do not appear to be copies of the foreign references listed on the IDS.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al. (US 2005/0021172), in view of Epstein (US 6,478,229).

Re claim 1, Winter et al. teaches an RFID incorporating barcode label comprising an RFID tag incorporated in the inside of a bar code sheet layer having a barcode on a front surface (FIG. 1, FIG. 2A+, and page 4, lines 5+ which teach the RFID can be carried on an additional independent layer, and paragraph [0067] which teaches RFID tags can be inserted in between the layers).

Winter et al. is silent to the RFID tag is interposed between two sheets constituting the sheet layer.

Epstein teaches a RFID tag interposed between two sheets and an adhesive layer (FIG. 2 and col 3, lines 50+), interpreted as a sheet layer comprising two sheets.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Winter et al. with those of Epstein.

One would have been motivated to do this use known techniques/methods to yield predictable results/similar results. In the instance case, one would have been motivated to use

the additional layer of Epstein in order to provide more protection and stability to the RFID device.

Re claim 3, the limitations have been discussed above. The release layer is interpreted as a release paper, as conventional in the art to cover an adhesive until it is desired to be used. The teachings of the two sheet members have been discussed above.

Re claim 4, though silent to the thickness of the second sheet member, the Examiner notes that it would have been obvious to one of ordinary skill in the art to have a .25-.35mm thickness of the second sheet since such modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of the ordinary skill in the art. In re Rose, 105 USPQ (CCPA 1955). One might desire a thicker sheet for a more prominent/durable label, reduction of cost, etc.

Re claim 5, antenna 28 is described as a dipole antenna.

Re claim 6, the Examiner notes that a pressure sensitive label (bonding) is taught by Winter et al. and Epstein. Though silent to attaching to a tire side face, the Examiner notes that the selection of what type of item to place the label on, is a matter of intended use, and therefore not patentable. Additionally, the Examiner notes that the placement of labels on items for information purposes is well known in the art, and one would have been motivated to apply the label to a tire side face, in order to provide tire or tire related information in an accessible location.

Re claim 7, a pressure sensitive adhesive is taught through adhesive 16 of Winter et al. Epstein teaches a pressure sensitive adhesive 12. One would have been motivated to use a pressure sensitive adhesive as set forth in Epstein based upon the materials/environment.

Re claim 8, though silent to managing tire information by reading the information written to the RFID tag on the tire, the Examiner notes that managing RFID tagged objects by reading the RFID tag is well known in the art, such as for inventory, record keeping, etc. Accordingly, it would have been obvious to manage the object which the tag is on, whether a tire (in this case) or other object, since the RFID tag stores information relating to the object, and is the data is read out by conventional reading apparatus. It would have been obvious to one of ordinary skill in the art to apply such known techniques to such a known device (RFID) to yield predictable results such as inventory/information management.

Re claim 9, the limitations have been discussed above.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al./Epstein, as discussed above, in view of Conwell et al. (US 2005/0221704).

The teachings of Winter et al. /Epstein have been discussed above.

Winter et al. /Epstein are silent to the tire and managing tires by reading.

Conwell et al. teaches a RFID attached to the outside of a tire (sidewall) (paragraph [0028 and [0002]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Winter et al. /Epstein with those of Conwell et al.

One would have been motivated to do this for collection of tire information (managing tires) throughout the wheel mounting and final assembly process, by applying a known technique to a device to yield predictable results.

4. Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 2004/0125040) in view of Winter et al., as discussed above.

Re claim 1, Ferguson et al. teaches a RFID tag interposed between two sheets (103 and 172) and an adhesive (170), interpreted as a sheet layer comprising two sheets. Ferguson teaches that the face stock is printable, but is silent to it being printed with a barcode.

Winter et al. teaches barcodes printed over RFID tags (on the sheet layer), as discussed above (FIG. 1).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to combine the teachings of Ferguson et al. with those of Winter et al.

One would have been motivated to do this to provide item identification that is machine/human readable by conventional devices to provide additional or reinforcing information (the claimed barcode sheet).

Re claim 3, the limitations have been discussed above. Paragraph [0071] teaches adhesives layer as claimed/bonding. Though silent to a release liner, it would have been obvious to one of ordinary skill in the art to provide a release liner (such as that taught by Winter et al.) in order to provide a means to cover the adhesive until application. The teachings of the two sheet members have been discussed above.

Re claim 4, though silent to the thickness of the second sheet member, the Examiner notes that it would have been obvious to one of ordinary skill in the art to have a .25-.35mm thickness of the second sheet since such modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of the ordinary skill in the art. In re Rose, 105 USPQ (CCPA 1955). One might desire a thicker sheet for a more prominent/durable label, reduction of cost, etc.

Re claim 5, paragraph [0007] teaches the use of a dipole antenna. A dipole antenna would have been obvious to one of ordinary skill in the art for a simple antenna suitable for RFID tags with reliable/predictable results.

Re claims 6-7, the Examiner notes that a pressure sensitive label (bonding) is taught (paragraph [0072] as an obvious expedient for adhering of tags. Though silent to attaching to a tire side face, the Examiner notes that the selection of what type of item to place the label on, is a matter of intended use, and therefore not patentable. Additionally, the Examiner notes that the placement of labels on items for information purposes is well known in the art, and one would have been motivated to apply the label to a tire side face, in order to provide tire or tire related information in an accessible location.

Re claim 8, though silent to managing tire information by reading the information written to the RFID tag on the tire, the Examiner notes that managing RFID tagged objects by reading the RFID tag is well known in the art, such as for inventory, record keeping, etc. Accordingly, it would have been obvious to manage the object which the tag is on, whether a tire (in this case) or other object, since the RFID tag stores information relating to the object, and is the data is read out by conventional reading apparatus. It would have been obvious to one of ordinary skill in the art to apply such known techniques to such a known device (RFID) to yield predictable results such as inventory/information management.

Re claim 9, the limitations have been discussed above.

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al./Epstein, as discussed above, in view of Conwell et al. (US 2005/0221704).

The teachings of Ferguson et al. /Epstein have been discussed above.

Ferguson et al. /Epstein are silent to the tire and managing tires by reading.

Conwell et al. teaches a RFID attached to the outside of a tire (sidewall) (paragraph [0028 and [0002]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Ferguson et al. /Epstein with those of Conwell et al.

One would have been motivated to do this for collection of tire information (managing tires) throughout the wheel mounting and final assembly process, by applying a known technique to a device to yield predictable results.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The applicant has cited new prior art (above) showing a RFID between layers, the two layers interpreted as comprising the barcode sheet layer/two sheet members.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL I. WALSH whose telephone number is (571)272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2887

/Daniel I Walsh/
Primary Examiner
Art Unit 2887